

REMARKS

Paragraph [0020] at page 5 of the Substitute Specification has been amended consistent with language of Example 1, as noted in paragraph 4 of the office action. Please note that the objection erroneously referred to the original specification rather than the Substitute Specification.

Responsive to paragraph 6 of the office action, claim 1 has been amended to more precisely specify the structural relationship between the various layers, as suggested by the examiner.

To the extent that the rejection under 35 USC 112, second paragraph, is based on the examiner's objection to the terminology "heat-reactive resin" the rejection is traversed. The examiner's attention is directed to the last four lines of claim 11 which serve to define the "heat-reactive resin." While the examiner indicates that he has "presumed" that the term refers to a resin having a heat-reactive functional group, such a presumption is not necessary because the last four lines of claim 1 clearly define the heat-reactive resin as a copolymer of at least first and second different monomers, one of the monomers being further defined as having a hydroxyl group.

The rejection under 35 USC 103 over JP 63-132097, optionally in view of Mori et al, is respectfully traversed. As interpreted by the undersigned, the Japanese reference lists a large number of UV or EB curable resins, some of which are heat-

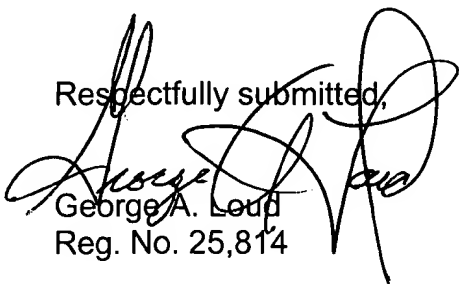
reactive. According to the examiner, because the Japanese reference further teaches that those listed compounds can be “mixed arbitrarily”, an obvious result of such mixing might be a heat-reactive resin as defined by applicants’ claim 1 in combination with an ionizing radiation curable resin. It is respectfully submitted that the examiner’s rejection is based on an erroneous factual premise. It is respectfully submitted that the examiner’s statement at the top of page 5 which reads “it is believed that the teachings of JP ‘097 clearly encompass the heat-reactive resin as claimed, as monomers such as... are conventional...” is incorrect. Such monomers as listed in the Japanese publication may well be conventional as asserted by the examiner. However, none of those disclosed “monomers” meets the definition of the “heat-reactive resin” as set forth in claim 1. Claim 1 defines the heat-reactive resin as “an acrylic copolymer of an acrylate or methacrylate monomer, as a first monomer, and a second monomer different from said first monomer and having a hydroxyl group...” JP ‘097 neither discloses nor suggests the hydroxy containing copolymer as recited by the last four lines of claim 1. None of the UV or EB curable resins disclosed in JP ‘097 is a copolymer and none contains a free hydroxyl group.

To the extent that the rejection relies upon Mori, it is further traversed. The examiner has suggested no adequate reason why one skilled in the art would have been motivated to use any resin disclosed by Mori in the resin of JP ‘097. The examiner asserts that one skilled in the art would have been motivated to make the combination or substitution “by the desire to obtain a coating composition having the proper applicability.” “Proper applicability” to what? The applicability taught by JP

'097 is a transfer sheet whereas the applicability taught by Mori is a protective film for a photomask. To transpose a teaching pertaining to a protective film to another reference and with the result being a pressure sensitive adhesive is the antithesis of obviousness. A protective film and pressure sensitive adhesives have different applicabilities.

However, even if the teachings of Mori would somehow be properly combinable with those of JP '097, the result would not be the invention as claimed. It is respectfully submitted that the examiner misinterprets the teaching at column 3, lines 31 and 32 of Mori referred to beginning with the third line from the bottom at page 3 of the previous office action dated September 8, 2003. At column 3, lines 31 and 32 Mori is not teaching any copolymer of 2-hydroxyethyl(meth)acrylate. On the contrary, at column 3, lines 31 and 32 Mori is teaching that the 2-hydroxyethyl(meth)acrylate residue may be the group represented by Formula II at the top of column 3 which group is suitable as Group "X" and "Y" in the phosphazene compounds of Formula I, shown to the bottom of column 2 of the reference. A careful reading of the reference reveals that the teaching at column 3, lines 31 and 32 relates to substituents for phosphazene compounds, i.e., to a specific group of phosphazene compounds, and in no way relates to any copolymer.

In conclusion, it is respectfully requested that the examiner reconsider the rejections of record with a view toward allowance of the claims as amended.

Respectfully submitted,

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